

No. 2306.

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IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT.

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OCTOBER TERM, 1913.

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**SHERMAN CLAY & CO.,**  
*Plaintiff in Error,*

*vs.*

**SEARCHLIGHT HORN CO.,**  
*Defendant in Error.*

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**Brief for Defendant in Error.**

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JOHN H. MILLER,  
WM. K. WHITE,  
Counsel for Defendant in Error.

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THE JAMES H. BARRY CO.

FILED

OCT 20 1913



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vs.	
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<i>Plaintiff in Error,</i>	
<i>Defendant in Error.</i>	

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BRIEF OF DEFENDANT IN ERROR.

This case comes here by writ of error to review a judgment entered upon the verdict of a jury in an action at law tried in the District Court for the Northern District of California.

The action was commenced in May, 1911, by the Searchlight Horn Company, defendant in error, to recover damages for infringement of letters patent, No. 771,441, for improvements in phonograph horns, granted to one Peter C. Nielsen on October 4, 1904,

and afterwards assigned to the Searchlight Horn Company.

Defendant in the lower court set up the usual defenses of want of invention, anticipation by prior patents and publications, prior use and manufacture by a large number of named persons, and also non-infringement. The case came on for trial before the court and a jury, Judge Van Fleet presiding, in October, 1912, and after a trial on the merits, the jury rendered a verdict in favor of the Searchlight Horn Company for \$3578.00, upon which a judgment for that amount with costs was entered on October 4, 1912 (Record, 15-16).

Afterwards defendant in error voluntarily remitted from the said money verdict all of the same except the nominal sum of \$1.00, and thereupon an amended judgment was entered for the sum of \$1.00 together with costs. The order amending the judgment and the amended judgment appear in the record at pages 18-20, and are dated June 2, 1913.

Plaintiff in error prepared a bill of exceptions, and on May 17, 1913, filed a petition for a writ of error to review the judgment of October 4, 1912, which awarded damages in the sum of \$3578, and on the same day filed an assignment of errors which appears in the record between pages 308 and 340. The court on the same day made an order allowing the writ of error upon the filing of a supersedeas bond, and there-

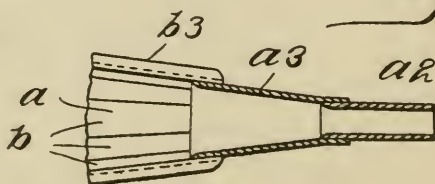
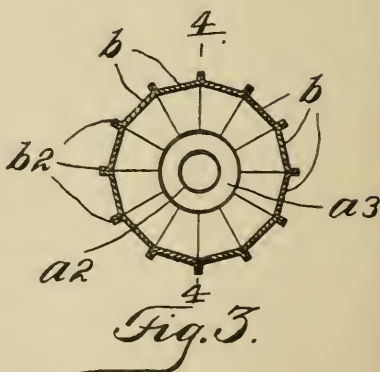
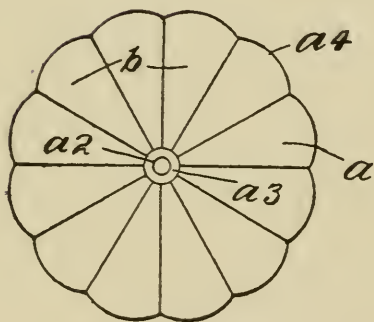
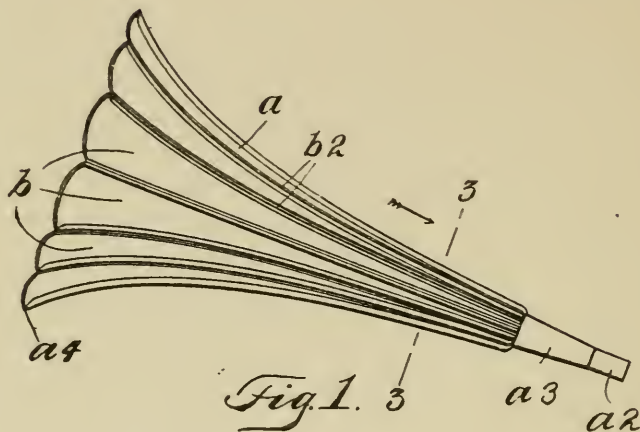


P. C. NIELSEN.

HORN FOR PHONOGRAPHS OR SIMILAR MACHINES.

APPLICATION FILED APR. 14, 1904.

NO MODEL.



WITNESSES

*Alb. Mattingly*  
*F. A. Stewart*

*Fig. 4.*

BY

INVENTOR

*Peter C. Nielsen,*  
*Edgar Peters*

ATTORNEYS

upon a citation was issued and the case is now here for review.

#### THE PATENT IN SUIT.

This patent is numbered 771,441, was issued October 4, 1904, to Peter C. Nielsen of Greenport, New York, and covers an improvement in horns for phonographs or similar machines. The application was filed April 14, 1904. The patent has not been made a part of the bill of exceptions, but the copy which was offered in evidence at the trial has been withdrawn from the files of the District Court and brought to this court and deposited with the clerk. On the adjoining page is a reproduction of the drawings of the patent.

The invention is a simple one and easily understood. It is stated in the specification that its object is

“to provide a horn for machines of this class which will do away with the mechanical, vibratory, and metallic sound usually produced in the operation of such machines, and also produce a full, even, and continuous volume of sound in which the articulation is clear, full and distinct.”

With that end in view the patentee has constructed a horn containing a multiplicity of metal strips, each being narrower at the inner end than at the outer end, and curved or tapered in plan gradually from the inner to the outer end, but with a greater or more abrupt curve or taper adjacent to the outer end

whereby a wide flaring outlet is produced. These strips are joined together at their longitudinal edges by a seam so as to form longitudinal ribs or projections on the outside of the horn, while the inner wall of the horn in cross section is substantially circular. In other words, a smooth inner surface and a longitudinally ribbed outer surface characterize the horn. The horn is bell-shaped, and is known in the art as the "Flower horn" because of the resemblance of its metal sections to the petals of a flower.

The specification further says:

"It is the construction of the body portion of the horn as hereinbefore described that gives thereto the qualities which it is the objects of this invention to produce, which objects are the result of the formation of the horn or the body portion thereof of longitudinal strips *b* and providing the outer surface thereof with the longitudinal ribs *b*<sup>2</sup> and curving the body portion of the horn in the manner described."

And further along in the specification, the patentee repeats himself by saying:

"and it is the longitudinal ribs *b*<sup>2</sup> which contribute mostly to the successful operation of the horn, said ribs serving to do away with the vibratory character of horns of this class as usually made and doing away with the metallic sound produced in the operation thereof."

The learned judge of the lower court very carefully analyzed the invention, and he had abundant oppor-



tunity to do so during the long trial, aided as he was by experts in the art and the argument of counsel on both sides. That analysis is found in his charge to the jury, beginning at the middle of page 271 and ending at the middle of page 273 of the record, the same being as follows:

“The invention consists of a horn for phonographs or similar instruments, and its objects are, as stated in the patent, to do away with the mechanical, vibratory and metallic sound usually produced in the operation of such machines, and to produce a full, even and continuous volume of sound in which the articulation is clear, full and distinct. The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent this seam is shown as being a flanged or butt seam, and these flanges extend outwardly, thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved or flexed outwardly, but this curve is more abrupt adjacent to the outlet of the horn or the mouth or large end, thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee has added the following clause:

“‘My improved horn may be used in connection with phonographs or other machines of this class and changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its object.’

“Now the invention actually covered by the patent does not reside in the particular form of

the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen's invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me, and the essential characteristics of the Nielsen horn are the following:

"1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.

"2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.

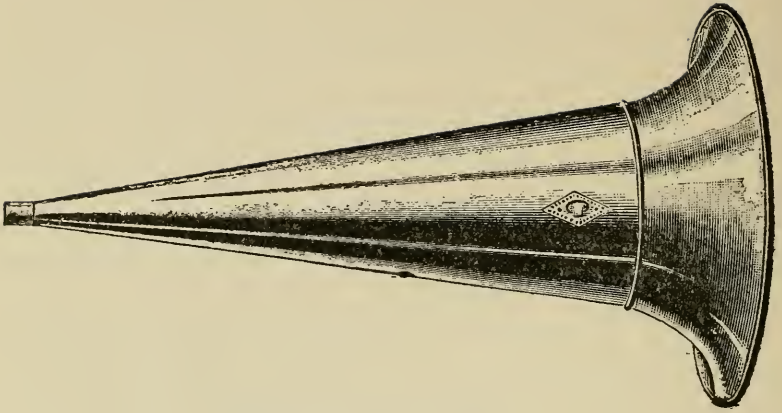
"3. The strips are narrower in cross-sections at the inner end than at the outer end.

"4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end.

"Now combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell-shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.

"This is an explanation of the invention in colloquial language rather than in technical form, and I instruct you that it correctly represents the in-





Black and Gold Horn.



Victor Trademark.

vention as protected by the claims in issue of the Nielsen patent."

These views constitute a clear exposition of the nature of the invention and perhaps no further remarks on the subject will be necessary; but we venture to add a few words which may be of some assistance.

Prior to Nielsen's invention many forms of horns for phonographs had been designed and experimented with, but the standard form used at that time was what is known as the "Black and Gold" horn, generally referred to as the "B. & G. horn." The upper cut on the adjoining page represents said horn.

This horn is also clearly shown in outline by the well known trade mark of the Victor Talking Machine Co., which was adopted many years ago at the inception of the art and consists of the picture of a horn with a fox terrier listening to "his master's voice" coming therefrom. The lower cut on the adjoining page is a reproduction of said trade mark. This B. & G. horn is composed of two distinct parts, (1) a conical shaped portion made of tin colored black, and (2) a separate bell of brass attached to the cone and colored gold. The conical part was generally made of a single piece of tin wrapped around a form in order to produce the conical shape, with a longitudinal lock seam forming a rib on the inside of the horn. Sometimes, however, this lock seam rib was placed on the outside of the horn. That

matter is immaterial. Sometimes also the conical part of the horn was made of two pieces or halves instead of one piece, that is to say, the two halves of the cone were bent in the required shape and then assembled together with lock seam ribs along their longitudinal edges. The brass bell was added to the end of the cone by means of a circumferential joint or rib of any desired character. This was the standard and generally used horn for phonographs at the time of Nielsen's invention. A few of them may still be found in use, but their manufacture has long since ceased and they have become obsolete. Their last vestige is preserved only by the trade mark of the Victor Talking Machine Company, where the fox terrier is shown to be on guard, so that we may literally say that these horns have been thrown to the dogs.

The defect in this B. & G. horn was that the music which passed through from the music box took on a "mechanical, vibratory, and metallic sound." The cause of this is apparent. When sound is passed through a horn made of a single piece of metal, the metal is thrown into infinitesimal vibrations, which produce "the metallic sound." These vibrations or sound waves are circular and extend all the way around the horn, just as when a pebble is thrown into a pond of water, circular ripples are produced which extend to the edge of the pond. In musical wind instruments, such as a cornet or trombone, it is very



desirable that the metallic vibrations should be set up, as they produce the music desired. Therefore, these instruments are made of spun brass, so that there may be no obstruction to the vibrations. Those vibrations are the thing desired. But with a phonograph horn a different problem is encountered. There the object is to reproduce the recorded music and vocal sounds in a full, even, and continuous volume, just as they have been recorded and without any interference or adulteration caused by their transit through the reproducing horn. If the voice of an opera singer is to be reproduced, it is desirable that it shall be reproduced just as it was sung into the instrument originally. Now in the horn in use prior to Nielsen's invention the vibrations of the metal constituting the horn mingled with the music which passed through the horn and so contaminated and adulterated the same as to set up the "mechanical, vibratory, and metallic sound" referred to in the Nielsen specification as so undesirable. In other words, a pure reproduction was not obtained. Possibly the members of the court can recall the fact that in the early days of the phonograph objections were made to the same on account of the squeaky, muffled, and metallic sound imparted to the music which was reproduced. This was due to the metallic vibrations of the horn as above pointed out.

Now Nielsen undertook to obviate this difficulty, and he attained the desired result by the construc-

tion of the horn covered by his patent. His idea was that by making the horn of a large number of narrow longitudinal metal strips joined together by ribs on the outside and curving or tapering these strips in plan so as to produce a bell-shaped horn which gradually tapers or flares from the inner to the outer end, he could "do away with" the effect of mechanical vibrations of the metal. In other words, the mechanical vibrations of those narrow strips would cease when they arrived at the longitudinal ribs instead of extending all the way around the horn as when made of one piece. The longitudinal ribs stopped the vibrations. When we say that these ribs stop the vibrations, we do not mean that they prevent any vibrations at all, because it is inevitable that the metal will have some slight vibrations; but we do assert that by the Nielsen construction the vibrations are reduced to a minimum, so that they have scarcely any appreciable effect upon the music passing through the horn. Such is the theory of the Nielsen invention.

Now let us see what effect it had on the art. Nielsen was not obtainable as a witness, but Christian Krabbe, a co-worker with him in the early art, was brought on from New York and testified as a witness at the trial. Mr. William H. Locke, Jr., president of the Searchlight Horn Company, also gave valuable testimony along the same lines. It appears from the testimony of these witnesses that immediately upon the introduction of the Nielsen patented horn, which



is referred to in the testimony as the "Flower" horn, the old style of horn then in use disappeared from the market, being entirely superseded by the Nielsen horn. According to Krabbe, the old style horns became junk and were sold for old brass, *while every manufacturer and dealer in the art adopted the Nielsen horn*. In other words, it is a case where the patented invention wholly superseded the old style of horns and captured the market. And furthermore, the patented invention continued to hold the market for years afterwards, in fact, until the present style of cabinet machine was put on the market known as the hornless machine. This brings the case directly within the decision of this court in *Morton vs. Llewellyn*, 164 Fed. Rep., 697, where the following language is used:

"Apart from the presumption of novelty that always attends the grant of a patent, the law is that where it is shown that a patented device has gone into general use, and has superseded prior devices, having the same purpose, it is sufficient evidence of invention in a doubtful case."

In view of the foregoing, it is idle for plaintiff in error to argue that the inventive faculty was not exercised by Nielsen in producing his horn. This case furnishes the most perfect instance of the presence of invention. Not only did the Phonograph Companies (Edison, Victor, and Columbia) adopt the device, but all the numerous manufacturers of and

dealers in horns throughout the United States did likewise. The patented device literally captured the entire market. Edison, the inventor of the phonograph, gave to it the tribute of his praise by adopting and using it through his company, National Phonograph Co.

On this subject the trial judge charged the jury as follows:

“A thing to be patentable must be the conception of the mind of the inventor as distinguished from the mere work of his hands as a skilled mechanic or artisan conversant with the art to which his production relates. It must be both new and useful; that is, new in the sense that the same conception or thing is not to be found in the prior art, and useful to a degree that it either brings about a new result or an old result in a substantially improved and different manner. A mere change in the form, or rearrangement of the parts of an old device without producing any new result or a result or function substantially different from the result or function of the old device does not constitute invention. No more exact definition can readily be given you of what constitutes invention as distinguished from mere mechanical skill; but there is one established principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case, if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid.

"If you find, therefore, that this is a doubtful case on the question of invention, and that after Nielsen's horn became known it went into general use and superseded the prior devices having the same purpose and theretofore used, you will be justified in giving effect to those facts in accordance with the rule of law pointed out, by finding that the device involved invention."

This instruction complied with the rule of law laid down by this court in the Morton case cited *supra*. In accordance therewith the jury found invention present. That was a question of fact, and it is conclusively settled by the verdict.

#### QUESTION OF INFRINGEMENT.

On this question surely there cannot be any possible doubt. The infringing horns are known as the "Victor horns," having been manufactured by the Victor Talking Machine Co. and supplied to their Pacific Coast agents, Sherman Clay & Co., the plaintiff in error. Those horns are identical with the horn shown in the Nielsen patent except for the slight mechanical change that a lock seam is employed instead of a butt seam. In the illustration shown in the Nielsen patent and described in the specification, the metal strips are joined together by what is known as a butt seam, that is to say, the edges of the strips are bent outward at a right angle to form flanges and these flanges are connected together by solder or any other appropriate device. Now, in the Victor horns the longitudinal

strips are joined together by a lock seam, that is to say, hooks instead of right angle flanges are formed on the edges of the strips, and these hooks interlock with each other and are hammered down so as to produce a rib on the outside of the horn a trifle flatter than the butt seam, but still a rib. This is the mechanical equivalent of the butt seam. At the time of Nielsen's invention both forms of seam were well known in the tinsmith art and were recognized as mechanical equivalents. On this point there is not the slightest shadow of a doubt.

Nielsen recognized this fact, because he used both forms in actual practice. The first horns he made contained the butt seam exactly as shown in his patent; but finding that it was a little cheaper or more convenient to use the lock-seam, he then made his horns with the lock-seam. Both styles of horns as made by Nielsen in the early part of 1904 are in evidence as exhibits, and the testimony of Krabbe is full and explicit on the subject.

Furthermore, Nielsen's patent contains the following clause:

"My improved horn may be used in connection with phonographs or other machines of this class, and changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages."

While it was not necessary to insert this saving

clause in the specification, nevertheless its appearance therein demonstrates beyond peradventure of a doubt that Nielsen contemplated using other forms of seam than the specific one shown in his drawings, and that he could do so without departing from the spirit of his invention.

And still further, it is clear to any discriminating mind that the two forms of joint are mechanical equivalents and that they may be used interchangeably according to the preference of the manufacturer. Both accomplish the same result, which is to connect the longitudinal edges of the narrow strips of metal and provide longitudinal ribs on the outside while the inside of the horn has a comparatively smooth surface. On this subject, the charge of the lower court was as follows:

“Now, while it is true that the drawings of the Nielsen patent show only the flanged or butt seam and not the lock seam specifically, and while it is true that the specification described only the flanged seam, nevertheless it is urged by plaintiff that the lock seam is the mechanical equivalent of the flanged or butt seam, and was known as such mechanical equivalent in the tinsmith art long prior to the time when Nielsen made his invention. Now, if you are satisfied from the evidence that the lock seam is the mechanical equivalent of the flanged or butt seam as a seam and strengthening rib, then the fact that the defendant has substituted and used the lock seam will not be sufficient to disprove infringement of the Nielsen patent; and in this connection I charge you that in



patent law two things are mechanically equivalent when they both accomplish substantially the same results in substantially the same manner, although they may differ somewhat in form and details of construction. The law does not require a patentee to put in his patent all the different forms in which his invention may be embodied. He is required to illustrate in his patent only one form, which must be the best form in which he has contemplated embodying his invention, and after he has done that, then the patent covers other forms which are the mechanical equivalent of the one shown in the patent. And furthermore, in this connection, you have a right to consider the clause in the Nielsen patent, that is:

“‘Changes in and modifications of the construction described may be made without departing from the spirit of my invention or sacrificing its advantages.’

“If, therefore, you find that at the date of the Nielsen invention the lock seam was the mechanical equivalent of the flanged or butt seam in the sheet metal art, and that they both accomplish the same result in substantially the same manner as a seam and rib when used in phonograph horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam. In other respects than in the form of the seam and in the presence of a rib it is not contended that the defendant's horn differs materially from that covered by the plaintiff's patent.”

(Record, pages 276-278).

It will be seen from the above that the question of

equivalency of the two seams was left to the jury. That was purely a question of fact to be determined by the evidence, and upon the evidence the jury found that the two seams were mechanical equivalents. This being a question of fact, it is conclusively settled by the verdict of the jury and can not be questioned in this court. (*Transit vs. Cheatham*, 194 Fed. Rep., 963).

### ASSIGNMENT OF ERRORS.

The assignments of error appear in the record between pages 308 and 340. They are 27 in number. Some of these assignments are so palpably without merit that probably they will not be urged; but we have not at this time received opposing counsel's brief, and, consequently, we do not know what course he will pursue in that regard. Therefore, prudence dictates that we notice all of these assignments of error. They comprise five classes: (1) those relating to admission and rejection of testimony, (2) one relating to motion for non-suit, (3) one relating to motion to direct a verdict, (4) some relating to instructions given, and (5) some relating to instructions refused.

#### ASSIGNMENTS RELATING TO REJECTION OF TESTIMONY.

These assignments are numbered I, III, and IV. No. I challenges the action of the court in overruling

the objection to the following question put to the witness Krabbe, viz.:

“Does a horn of that kind conform to the patent in suit?”

The proceedings in reference to this matter will be found at pages 70-1. The horn referred to was one produced by the defendant and marked for identification as exhibit Z. It was shown to the witness on cross examination and he testified that the Searchlight Horn Company had made horns of that kind, but he did not know when the Company started such manufacture. Apart from the fact that this matter was not legitimate cross examination, inasmuch as the witness had not been asked anything regarding the matter on his direct examination, the question was clearly improper as calling for a question of law. Whether or not the horn conformed to the patent was a question of law for the court to determine, and, therefore, it was improper to ask this witness such a question. Even if the witness had been produced as an expert, the question would have been improper; but he was not even produced as an expert. And furthermore, it is utterly immaterial whether the horn conformed to the patent or not, being a horn made long after the issue of the patent.

ASSIGNMENT III challenges the action of the court in refusing to admit in evidence re-issue patent 12,442,



granted to one Villy on January 30, 1906. This re-issue patent was objected to by plaintiff in the court below on the ground that it was subsequent in date to the Nielsen patent (Record 128). The original Villy patent, of which it was a re-issue, was offered in evidence, and plaintiff in error was entitled to whatever consolation he could get out of it; but the re-issue of the patent, being long after the date of the Nielsen patent, was immaterial for any purpose whatever.

ASSIGNMENT IV challenges the action of the court in sustaining our objection to the following question asked the witness Wm. H. Smith: "With the patent in  
 "suit before you, will you please compare the device  
 "therein disclosed with the device which you find in  
 "'Defendant's Exhibit Tea Tray Horn No. 20,' and  
 "state such differences and similarities as you find  
 "existing between the two."

This matter is found on pages 195-6 of the Record. Our objection was to the form of the question in that it allowed the witness, who was a patent expert, to determine for himself the question of law as to what was covered by the patent in suit, and then to compare the thing thus supposed to be covered with the Exhibit referred to in the question. This was clearly the idea of the trial judge, who said on page 195:

"The witness will be confined to describing the

mechanism of any of these devices that are shown to him in the prior art, and the jury will say whether they are such as to show an anticipation here under the instruction of the court."

Thereupon counsel acquiesced in the ruling of the court as to the objectionable form of a similar question theretofore asked the witness regarding all the devices of the prior art and then proceeded to ask the question now under consideration, respecting one particular device of the prior art, which is exactly the same form as the question theretofore ruled on. We objected to the form of this question, not to its substance, and stated that we were willing that the witness should describe the construction of what he had in his hand, which was the Tea Tray Horn No. 20, but that it was for the jury to say what was the difference and similarity. Thereupon the court sustained our objection to the form of the question, ruling that the witness must confine himself to describing in a mechanical way, in a scientific way, the construction of the devices described in any of the prior patents, and then it was for the jury to say whether they were anticipations, it being beyond the province of the witness to say whether they were anticipations or not. This ruling was clearly correct. But whether it was correct or not, the witness was allowed by the next question to bring out everything that was inquired for by the objectionable question; for on pages 196-7 we

find that the very next question asked the witness was as follows:

“Please examine the Tea Tray Horn and state the construction of that device, how it is formed, and how the parts going to constitute the body of the horn are united and joined together.”

The witness was allowed to answer this question in detail. Consequently, the plaintiff in error really obtained all the information which it sought to obtain by the objectionable question which had been ruled out.

#### ALLEGED ERROR OF COURT IN DENYING MOTION FOR NON-SUIT.

This is assignment of error II. There is no such thing known in patent practice in the Federal courts as a non-suit, and we assume that counsel meant a motion for the court to instruct the jury to render a verdict for the defendant. But it is well settled that a denial of such a motion is no ground of exception if the defendant afterwards proceeds to make a defense by putting in evidence, as was done in this case. Furthermore, no such motion appears in the record and no such exception is therein found. This assignment of error is clearly frivolous.

ASSIGNMENT OF ERROR IN REFUSING TO INSTRUCT THE  
JURY TO RENDER A VERDICT FOR DEFENDANT.

This is assignment V, and the matter appears on page 267 as follows:

"The defendant moved the court that the jury be directed to find a verdict for the defendant upon the ground that claims 2 and 3 of the patent in suit are void for want of patentable invention and that neither of said claims have been infringed by the defendant. . . ."

In the first place it does not affirmatively appear from the record that it contains all the evidence which was before the jury. Such a motion must be based on *all the evidence*. Yet the bill of exceptions is silent on this subject. It does not state that it contains *all* the evidence which was introduced. For aught that appears from this record there may have been other and material evidence before the jury which is not in the bill of exceptions. As every presumption is *in favor* of the correctness of the judgment, this assignment of error cannot be considered.

But considering the matter on its merits, the request was properly refused. It will be observed that it was based on two propositions, viz.: want of patentable invention and non-infringement. Both of those questions were questions of fact, and being such, were properly submitted to the jury. The rule regarding the giving of an instruction to a jury to find one way

or the other is well settled and needs not the citation of many authorities. The latest exposition of the law on the subject was given by the Court of Appeals for the 8th Circuit last March in the case of *Liberty Bell Gold Mining Co. vs. Smuggler Union Mining Co.*, 203 Fed., 800, where the following language was used:

“To justify the court in withdrawing an issue from the jury, it must appear that, giving the evidence the strongest probative force against the party asking for the withdrawal, there was no substantial evidence which would warrant a jury finding that issue against him. It is only when all reasonable men, in the honest exercise of a fair and impartial judgment, would draw the same conclusion from the evidence on that issue, that it is the duty of the court to withdraw it from the jury.”

This ruling is supported by the citation of a large number of cases from the Supreme Court. We may add to that list the following authorities:

*Tucker vs. Spalding*, 13 Wall., 455;  
*Bischoff vs. Wethered*, 9 Wall., 814;  
*Battin vs. Taggert*, 17 How., 84;  
*Coupe vs. Royer*, 155 U. S., 579;  
*Patton vs. Texas & Pac. R. R. Co.*, 179 U. S., 660;  
*Keyes vs. Grant*, 118 U. S., 25;  
*Royer vs. Schultz Belting Co.*, 135 U. S., 319;  
*Mitchell vs. Tilghman*, 19 Wall., 118;  
*Curtis on Patents*, Sec. 469, and  
*3 Robinson on Patents*, page 378.

Stated in a nutshell, the rule is that if there was any evidence of invention and infringement, which, if credited by the jury, would have justified their verdict, then the instruction was properly refused. In this connection it must be remembered that the request admitted the truth of all the evidence introduced by the plaintiff, as well as all conclusions of fact which reasonable men might fairly draw therefrom. Such was the rule laid down by Chief Justice Marshall in *Pawling vs. U. S.*, 4 Cr., 219, and subsequently followed in *U. S. Bank vs. Smith*, 11 Wheaton, 117, *Merrick's Exrs. vs. Giddings*, 115 U. S., 300, and many other cases.

One of the latest decisions on the subject is that of *Transit Co. vs. Cheetham*, 194 Fed., 964.

Now, applying these principles to the case in hand, it is idle for plaintiff in error to argue that there was before the jury no evidence whatever on the subject of invention and infringement, which, if believed by the jury, would have justified them in rendering a verdict in favor of the patent owner. The most casual perusal of the testimony offered on the subject will disprove the contention, and it would be a waste of time to dwell further on the subject. Furthermore, the evidence introduced by the defendant below not only fails to weaken the case that had been made out by the plaintiff below, but strengthens the same, be-



cause that evidence shows that many efforts and trials had been made in the prior art to produce a perfect phonograph horn without success. Many prior patents were put in evidence, but none of them showed the Nielsen invention or anything like it, thereby inducing the conclusion that others had failed where Nielsen succeeded. To sum up the whole matter in a nutshell, the record shows this condition, viz.: that all of the horns of the prior art were defective and unsatisfactory in that they produced a mechanical, vibratory, and metallic sound which vitiated the music, that the curing of such defect was desirable and others had tried but failed, that the Nielsen invention cured the defect and produced the perfect horn, that as soon as it was made known it was universally adopted by all the phonograph companies as well as the manufacturers of and dealers in phonograph horns, and that the horns of the prior art were all consigned to the scrap pile. In fine, the Nielsen invention completely captured the market, lock, stock and barrel, and continued to be the universally accepted and used horn for all time thereafter until the cabinet machines were introduced on the market known as the "hornless machine." This is a fair statement of the record, and in view thereof it was not error on the part of the learned judge of the lower court to refuse the request for a peremptory instruction in favor of the defendant.

lished principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case, if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid."

Possibly the matter may be reached by plaintiff in error's exception "to that part of the charge on the subject of sufficiency of invention," though we doubt it. What did the learned counsel mean by objecting to the charge relating to "the sufficiency of invention"? And can that exception be applied to this particular portion of the charge? Other portions of the charge also related to the sufficiency of invention, or rather to the question of invention, and this exception may have been intended to apply to those portions of the charge. What counsel should have done was to have excepted specifically to this portion of the charge. There is no specific exception to this portion of the charge, and we think the exception is framed in such general language that it can not be considered. But however that may be, this portion of the charge was not error. On the contrary it was the rule of law established by this court in the case of *Morton vs. Llewellyn*, 164 Fed., 693, where the court used (697) the following language:

"Apart from the presumption of novelty that



always attends the grant of a patent, the law is that where it is shown that a patented device has gone into general use, and has superseded prior devices having the same purpose, it is sufficient evidence of invention in a doubtful case."

In support of that rule of law this court then cited several cases from the Supreme Court, and there is no doubt that the rule of law is correct. It is the rule of law on the subject which has been laid down by this court to be followed by the lower courts in trying patent cases. The learned judge of the lower court followed that rule of law in the present case, and surely it can be no error for the lower court to have followed a rule of law laid down by this court as well as by the Supreme Court.

ASSIGNMENT IX challenges that part of the court's charge beginning near the bottom of page 277, which instructs the jury that if they find as a fact that at the time of Nielsen's invention the lock seam was a mechanical equivalent of the butt seam in the sheet metal art, and that they both accomplish the same result in substantially the same manner as a seam or rib when used in phonograph horns, then they must find that the two things are mechanical equivalents, and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam. We fail to see how any objection can be made to this portion of the charge. The court did not say that the two joints were mechan-

ical equivalents, but left it to the jury to find if they were, and merely told them that if they did find the two joints to be mechanical equivalents, then the use of the lock seam would not of itself relieve the defendant of the charge of infringement. The question of mechanical equivalents is purely one of fact, and, therefore, it was proper for the jury to decide it. It may be that counsel's contention under this head will be that the plaintiff below was not entitled to the doctrine of equivalents at all, that being the way he has framed his exception (Record 282). If so, the point is not well taken, for all patents are entitled to the doctrine of equivalents. The dispute generally arises as to the extent of the equivalency. Where the invention is a broad one, the doctrine of equivalency is correspondingly broad; where the invention is a narrow one the doctrine of equivalency is correspondingly narrow. But in all cases the patentee is entitled to the doctrine of equivalents to some extent (*Paper Bag Cases*, 210 U. S., 405). The exception here challenges the right of the patent owner "to the doctrine of equivalents at all." Clearly such an exception is without merit.

The next succeeding exceptions, viz.: that the lock seam joint may be considered the equivalent of the flanged joint, also that any other joint which the jury may find to accomplish the same result, may be adopted instead of the flanged joint, are equally without merit, because the charge nowhere tells the jury that the

lock seam joint may be considered the equivalent of the flanged joint, nor that other joints, which the jury may find to accomplish the same result, may be adopted instead of the flanged joint. On the contrary the charge tells the jury to find whether or not the lock seam joint is the equivalent of the flanged joint, and then explains to them as a matter of law that if they find such equivalency, infringement is not avoided by merely using the equivalent form. This was a clear exposition of the law on the subject. On the doctrine of equivalency in patent cases see *Paper Bag Case*, 210 U. S. 405, where the subject is exhaustively discussed.

ASSIGNMENT OF ERROR RELATING TO THE REFUSAL OF  
THE COURT TO GIVE CERTAIN INSTRUCTIONS RE-  
~~QUESTED~~  
~~QUIRED.~~

These assignments, from and including assignment X to and including assignment XXVII, are found between pages 313 and 339.

ASSIGNMENT OF ERROR X is double-barreled in character, one part undertaking to tell the jury that the patent in suit "necessarily belongs to a class which is very narrow," and the other part undertakes to tell the jury that if the defendant's horn is not "of the precise description, construction and mode of operation disclosed in one or more of the claims mentioned in the patent," then the verdict must be for defend-

ant. In the first place whether the invention was a pioneer or narrow one was a question of fact for the jury (*Transit Development Co. vs. Cheatham*, 194 Fed. Rep., 963), and it would have been error for the court to have passed on it. Furthermore, in this case the question was of no moment. The defendant had used the exact construction shown in the patent except that it had varied the form of seam from the flanged to the lock form, and the court left to the jury to determine whether the lock form was the equivalent of the flanged form. Furthermore, it would have been error to limit the patent to "the precise description and construction" shown in the patent, because that would have been to wholly deprive the patentee of the doctrine of equivalents. And furthermore, the request covered by this assignment of error was argumentative in form and for that reason improper.

ASSIGNMENTS OF ERROR XI, XII AND XIII tell the jury that the patentee can not make an infringement out of something from which he differentiated his invention in the Patent Office in order to obtain a patent, and then go on and repeat certain claims which were asked for by Nielsen in the Patent Office and rejected, and then draw therefrom the conclusion that these rejected claims represent the defendant's structure, and, therefore, the claims of the patent which were allowed can not be held broad enough to cover the defendant's structure.

These requests were wholly improper. In the first place they were argumentative in form and unintelligible to the jury. Neither do they cover any issue in this case, because it was never contended by us that the claims of the patent must receive such construction as the rejected claims in order to make out infringement. And still further the matter covered by the requests was one with which the jury had no concern. Filewrapper contents are admissible for aiding the court in construing the patent, not for aiding the jury. The court alone may construe the patent, and the jury has nothing to do with it. In this case the court considered the filewrapper contents and then construed the patent, giving to the filewrapper contents such force and effect as the case demanded, consequently there was no error in <sup>act</sup> discussing with the jury the filewrapper contents, and that is in substance what these three instructions requested.

While it may not be necessary for us to dwell further on this matter, we venture to offer a few suggestions showing that the learned judge of the lower court was clearly right in his conclusion that there was nothing in the filewrapper contents to militate against the construction he gave the patent.

The application as originally filed contained three claims, of which claims 1 and 2 are the present claims 1 and 2 of the patent and were allowed without objec-

tion. Original claim 3 of the application read as follows:

"A horn for phonographs and similar machines, said horn being tapered in the usual manner, and the body thereof on the outside thereof being provided with longitudinally arranged ribs, substantially as shown and described."

This claim 3 was rejected on the English patent to Tourtels, No. 20,557, and United States patent to Fallows, No. 181,159, which show a single-piece metal horn of conical shape provided with *corrugations* on the outside—in other words, a single-piece corrugated horn.

This rejection was proper, because claim 3 as presented, was too broad. According to its language it was not required to be made of a plurality of metal strips, but the claim was sufficient to cover a horn made of a single piece of metal folded into conical shape and having corrugations on the outside. In fact the claim did not call for metal strips at all, or any kind of strips. It might have been made of paper, glass, wood, celluloid or any other material so long as it was tapered and had ribs on the outside.

Thereupon on June 7th, the applicant added another claim, number 4, reading as follows:

"4. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs



between which the longitudinal parts of the horn taper from one end to the other, substantially as shown and described."

This claim 4 was not materially different from the former claim 3 which had been rejected, and it was promptly rejected, the Office citing, in addition to the former prior patents cited, that of Clayton, No. 612,639, which shows an ear trumpet in which there is a so-called horn made of one piece of metal and corrugated in radial lines. Original claims 3 and 4, as presented by the applicant, were broad enough in language to cover this Clayton device; hence, they were rejected.

Thereafter the applicant added another claim, numbered 5, reading as follows:

"5. A horn for phonographs and similar instruments, said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described."

It will be seen that this claim was likewise too broad because it covered a horn made of "tapered strips secured together at their edges" in any manner whatever. No particular method of securing these strips together was specified. It might have been by a flexible hinge (in which event it would cover the old Villy horn), or by a rigid wire staple, or by adhesive tape, or by any form of jointure whatever. It is also to be noted that this claim did not call for metal strips,

but any kind of strips, paper, cardboard, glass, celluloid, or any other material. Nor did this claim 5 call for any ribs at all. But in the Nielsen invention (claim 3) it is essential that the strips must be of metal and must be secured together along their edges in such manner as to provide longitudinal ribs on the outside, while the inside of the horn is substantially smooth. Such was the construction put on the patent by the court. Consequently, original claim 5 was properly rejected as too broad and as covering something not included in the Nielsen invention.

Applicant then filed another claim, No. 6, which is the present claim 3 of the patent. This new claim 6, now numbered claim 3 of the patent, was accepted by the Patent Office without question and never was rejected.

From the foregoing, it will be seen that the present claims of the patent, each and all of them, were allowed in the form in which they were presented, and that there never was any amendment to them made for the purpose of securing their allowance.

What does appear is that three other claims were proposed by the applicant and asked for and were all rejected. Two of those other claims (3 and 4) were sufficient in form to cover a horn made of a single piece of any material folded in conical form and either provided with corrugations in the material itself or having attached to the outside of the horn separate ribs. Clearly this was not within the purview of Niel-



sen's invention, because his patent shows that his invention contemplated a horn made of a plurality of metal strips joined together at their edges in such a way as to form longitudinal ribs on the outside of the horn, the said horn being flexed or tapered in such a way as to present an outwardly flaring mouth. Now these two rejected claims went far beyond this invention, and for that reason were very properly rejected. They were sufficient in language to cover two forms of horn other than Nielsen's viz: (a) a horn made of a single piece of corrugated material of any kind folded in conical shape with the corrugations on the outside; (b) a horn made of a single piece of material of any kind folded together in conical shape and provided on its outside with longitudinal ribs made of separate pieces and attached to the outer surface of the horn. The other rejected claim (claim 5) was broad enough to cover a horn made of any material and having no ribs at all and composed of strips joined together by any kind of a joint (e. g. a horn made of paper strips joined together by adhesive plaster). Hence it was outside of Nielsen's invention. It was for these reasons that the three claims were rejected. They were entirely too broad and covered something which Nielsen never invented. Consequently, Nielsen acquiesced in that rejection, and his other three claims (the present three claims of the patent) were allowed by the Patent Office without any criticism or rejection whatever.

In view of these facts, it is idle to assert that Nielsen's present three claims are in any way affected by the action of the Patent Office as to the claims which were rejected.

We understand the rule of law invoked by plaintiff in error to be this: where an applicant presents a claim which is rejected on references, and he then amends the claim by narrowing it so as to avoid the references, he cannot afterwards contend that such claim as allowed covered what was rejected, and his claim as allowed must be construed in connection with the rejection. In other words, the rejection limits and defines the claim by excluding from its purview what was rejected. But here Nielsen's claims 1, 2 and 3 never were rejected. They were allowed as presented. The rejections which were had related to three other proposed claims, which on their face were wholly different from claims 1, 2 and 3, and which on their face were too broad as including something not within the purview of Nielsen's invention, and for which reason they were rejected. The utmost that defendant could claim is that the present claims 1, 2 and 3 can not be construed broad enough to cover what was covered by the three rejected claims. We are perfectly willing to accept that proposition, because the three rejected claims were rejected because they covered a one piece horn of any material having corrugations on the outside, or separately attached ribs on the outside, or a horn with no ribs at all. That is the sum

and substance of the Patent Office ruling. It was entirely correct and there is nothing in it to limit the three claims of the patent which were allowed. This is not a case for application of the rule of law advanced by plaintiff in error and referred to in *Knapp vs. Morss*, 150 U. S. 221. That ruling is more clearly stated in the case of *Corbin vs. Eagle*, 150 U. S. 40, where the syllabus reads as follows:

“When an applicant for letters patent makes a broad claim which is rejected, and he acquiesces in the decision and substitutes a narrower claim therefor, he cannot insist upon a construction of the narrowed claim which would cover what was so rejected.”

Applying that rule of law to the case in hand: the rejected claims covered a horn made of a single piece of material of any kind with corrugations or separately attached ribs on the outside. As applicant acquiesced in that rejection, he cannot now contend that any of his claims cover such a construction, nor do we make such contention.

But furthermore, it is to be noted that the present claims 1, 2 and 3 were not, nor was any one of them, substituted for the rejected claims. On the contrary, they were independent claims presented and pending in the Patent Office at the same time with the rejected claims, and hence this is not a case of the substitution of a claim for one which had been rejected. So that in any event, that rule of law can not apply.

ASSIGNMENT OF ERROR XIV relates to the refusal of the court to give instructions concerning the scope of claim 1 of the patent. This assignment of error is bad because claim 1 was not involved in the suit. It appears from page 63 of Record that claim 1 was not charged as an infringement and that the only claims relied upon in the case were claims 2 and 3. Claims 2 and 3 were the only ones submitted to the jury, and claim 1 never was before them for consideration. Consequently, any instruction regarding claim 1 was improper as being something outside of the issues.

ASSIGNMENT OF ERROR XV IS AS FOLLOWS:

“The court further instructs you that the second claim of this patent is the same as the first with the exception that it specifically calls for the strip being tapered from one end of said horn to the other, and the same instruction that the court has given you concerning claim 1 applies with equal force to claim 2.”

Such an instruction would not have been good, because claim one was not in the case and no instruction had been given regarding claim 1. Hence this requested instruction would have been unintelligible.

ASSIGNMENT OF ERROR XVI is liable to the same objection as the last mentioned assignment of error in that it refers to claim 1 and undertakes to tell the difference between said claim 1 and claims 2 and 3. Furthermore, it is double-barreled, or rather triple-bar-

reled, in that it undertakes to treat of three of the claims en masse and it is not sufficiently specific. Furthermore, the refusal to give it did not injure the plaintiff in error, and if it had been given the jury would have been compelled under the same to have found in favor of the plaintiff below, for this request says, amongst other things, "the method of securing the edges of the strips is no part of this claim. . . . The union of the strips or longitudinal seams constitutes one element of the claim and the formation of the ribs at such point of union of the seams another element of the claim, and it is necessary that these two elements be present in order to constitute an infringement of the claim. In other words, claim 3 differs from claims 1 and 2 inasmuch as it required the formation of a seam or joint union and the formation of a rib adjacent such formed seam."

According to that, the jury would have been compelled to find infringement of claim 3, because this request tells the jury in substance that any kind of a joint union which resulted in an outside rib was an infringement. Consequently, plaintiff in error cannot complain of the refusal of the court to give this instruction.

ASSIGNMENT OF ERROR XVII undertakes to tell the jury that the invention "is a very narrow one," and that consequently the doctrine of equivalents must be correspondingly limited. It was no part of the court's

duty to tell the jury that this invention was a narrow one. That was a question of fact that the jury should determine on all the evidence before it (*Transit vs. Cheatham*, 194 Fed., 963). Further, the question of the breadth or narrowness of the invention was not a material issue; for, as we have already pointed out, the sole mechanical difference between the two structures resided in the fact that the infringing devices employ a lock seam instead of a flanged seam, and the only question for decision was whether the lock seam was an equivalent of the flanged seam. That matter was left for the jury to decide. Consequently, it would have been confusing to the jury and wholly out of place for the court to have instructed them regarding the narrowness of the invention and to tell them that the doctrine of equivalents in such a case is necessarily limited. When the court told the jury that the only difference between the two structures resided in the form of the same, and that it was for them to determine whether the two forms of seam were mechanical equivalents or not, that was the utmost extent to which the court had a right to go. It was a palpable fact, shown by comparison of the two horns, that the only difference in structure resided in the different form of seam, and the evidence was conclusive that the result produced by the two forms was exactly the same, and that the two forms had been known for years to be mechanical equivalents of the sheet metal art. This was the



whole question in the case. There is nothing else to it, and it was a question of fact for the jury to decide irrespective of the breadth or narrowness of the invention.

ASSIGNMENT OF ERROR XVIII is purely argumentative on questions of fact. The most casual reading of the same, comprising over two pages, will show that it was not the proper form of instruction to give to a jury.

ASSIGNMENT OF ERROR XIX is bad for several reasons. In the first place it undertakes to charge the jury regarding matters of fact, and the Court said in that behalf: "I do not charge on the facts. The facts are for the jury." It is also improper in that it says in reference to the Nielsen invention that it "seems to be one that might suggest itself to any skilled mechanic or expert who knew, if it is a fact, that the old style of horn did cause a mechanical vibratory and metallic sound." That was a question of fact for the jury to determine and it was improper for the court to express an opinion on it. The asked instruction was also improper because it says at the close thereof "The real cause, if any, why these ribs and strips produce this effect, was, because they tended to strengthen the body of the horn, and it may be assumed, that if the same strength was given to the body of the horn by an addition of metal, the same result would necessarily be produced."

That was purely a question of fact for the jury, and

it would have been error for the court to have given the instruction. This assignment XIX is also liable to the objection interposed to some of the others in that it is not limited to one specific thing, but is multiple in character relating to several different things confused and jumbled together in a mass. Even if one or more of the ideas there involved were correct, it is clear that others were incorrect, and, therefore, the instruction as a whole was improper.

ASSIGNMENT OF ERROR XX relates to the question of invention as distinguished from that of mechanical skill, and undertakes to give a dissertation on the subject containing sentences quoted from decisions of the Supreme Court. Those rules of law may be correct as general principles, but they have no application to the case at bar. They are highly argumentative in form and would serve only to confuse and befog the mind of the jury. Furthermore, the court had correctly charged the jury regarding the subject matter, beginning at the bottom of page 273 of the record. And furthermore, the charge is of a multiple character relating in part to a question of law and in part to question of fact, giving definitions from Webster's Dictionary and introducing extraneous matter which would not serve to enlighten the jury. Clearly such an instruction was improper.

ASSIGNMENT OF ERROR XXI is a three-page dissertation on the general principles of law relating to inven-

tion. Many of the statements therein contained are correct as general principles of law, but the whole, taken together, is discursive, confusing, argumentative, and not proper for an elucidation of the issues involved. Whatever principles of law therein contained which are correct had already been given in other language to the jury. No error was committed in refusing this request as a whole, and no injury was done to the plaintiff in error; for if it had been given, we can not see how the verdict could have been different.

ASSIGNMENT OF ERROR XXII is along the same lines, and in addition to the objections heretofore noted is liable to a still further objection that in undertakes to tell the jury that if any of the prior devices is composed of more than one strip (2, for instance) with ribs on the outside formed by a joint, then the patent is anticipated. This assumes that the invention consists of but two elements, to wit, a plurality of strips with ribs on the outside. But this is not the invention. The invention consists of a combination of elements, of which those mentioned are two of the elements. Besides these there are other elements in the combination, notably the shape of the horn and the curving or tapering of the strips in plan gradually towards the outer end, where the curve is more abrupt, whereby a flare or bell shape is produced. These elements are correctly specified by the learned Judge of the

lower court at pages 272-3 of the record. Hence, we see that request XXII contains an improper construction of the patent, and it was properly refused.

ASSIGNMENT OF ERROR XXIII also contains an erroneous idea, besides being an instruction regarding matters of fact. The court told counsel that he did not instruct on matters of fact, but left that to the jury. Furthermore the request relates to the question of invention which had already been fully covered by the general charge. This request was argumentative regarding matters of fact and wholly improper.

ASSIGNMENT OF ERROR XXIV is of no avail. The first paragraph thereof reads as follows: "A mere change  
" in form of an old machine, or the mere rearrange-  
" ment of the parts of an old machine without pro-  
" ducing any new result or any result or function sub-  
" stantially different from the result of function of the  
" old device does not constitute invention." The court gave that instruction. On page 274 of the record we find in the charge of the court the following: "A  
" mere change in the form, or rearrangement of the  
" parts of an old device without producing any new  
" result or a result or function substantially different  
" from the result or function of the old device does  
" not constitute invention." The court took this quotation from the request aforesaid, with a slight change of verbiage.

The second paragraph of assignment of error XXIV

is merely an elaboration of the first paragraph as applied to this case, and, as the first paragraph was given, it was no error to refuse the second.

The third paragraph of assignment XXIV is argumentative in form and improper, but the substance of it was given when the court told the jury that a thing to be patentable must be the conception of the mind of the inventor as distinguished from the mere work of his hands as a skilled mechanic or artisan conversant with the art to which his production relates (Record, 274).

ASSIGNMENT OF ERROR XXV undertakes to charge on questions of fact by telling the jury that the prior art in the case "suggests the same cooperation of the same elements and upon the same principle adopted by the patentee." The court had already instructed the jury on the subject of anticipation by saying at page 275, "The other defense advanced by the defendant against  
" the validity of the patent is that of anticipation, and  
" by that expression is meant that the thing covered  
" by Nielsen's patent had been known or used by other  
" people or described or shown in some other patent  
" or publication before Nielsen made his invention.  
" If that is true, of course Nielsen was not the first  
" inventor, and his patent would therefore be invalid  
" for that reason, because a patent can be granted  
" only to the first and original inventor." After that

instruction was given it was no error to refuse request XXV.

ASSIGNMENT OF ERROR XXVI covers six and a half pages of the record. It relates to many different matters, and is a jumbled and confused mass of legal principles and matters of fact alleged to be shown by the evidence. The form of it alone would be sufficient for its disallowance. In framing special instructions for a jury, it is improper to write a dissertation on patent law or to argue the facts shown upon the record. Whatever law was applicable to the case had already been given by the court; what the facts were was for the jury to determine. There are many errors in this request XXVI. The first part of it undertakes to tell the jury that the invention could not be classified as a primary one, but that it clearly appears that it concerns only improvements in a well developed art and accomplishes results not new. Such an instruction as that would have been error, as it relates to a matter of fact for the jury to determine (*Transit vs. Cheatham*, 194 Fed. Rep., 963). The said request also undertakes to tell the jury that the plaintiff is entitled "only to a very narrow construction of equivalents," and that it is entitled only to "the specific device of his patent with such plain equivalents which go to show a clear attempt at mere evasion." And further on in the instruction it is urged that plaintiff is entitled only to the *specific form of construction*



shown in his patent, which specific form consists in utilizing with the other elements a flanged joint. Such is not the proper construction of the patent. The invention did not reside in the form of the joint or ribs. The patentee illustrated one form, the flanged form, because the law requires that he shall illustrate one form, and further provides that he shall illustrate only one form. If the invention can be embodied in other forms, they are included within the purview of the patent, and the specification expressly states "that changes in and modifications of the construction described may be made without departing from the spirit of the invention or sacrificing its advantages." Whether or not the lock form was the equivalent of the flanged form was a question of fact to be decided by the jury, and it would have been error to have told the jury that the plaintiff was limited to the flanged form.

The other portion of this request XXVI (Record, 334) undertakes to tell the jury in so many words that the lock-seam "cannot be construed to make the joint called for in either of the claims of the plaintiff's patent." As we have already stated, that was a question of fact for the jury to decide, and it would have been error for the court to have taken it away from them.

Further along in this request it is stated that the defendant does not infringe unless its horns show the flanged joints as counterdistinguished from the old

lock-seam joint. And the same matter is further elaborated specifically in the request. As we have already pointed out, it would have been error to have given such a construction because that would have confined the plaintiff's invention to the precise form of joint, to wit, the flanged joint, shown in the drawings of the patent, and would not have allowed the plaintiff the doctrine of equivalents.

Another error of this request, beginning at the bottom of page 336, is that by it the jury would have been told that the invention has nothing to do with the *shape* or *configuration* of the horn, but is confined to the manner of constructing the joint between the strips, and the jury was requested to disregard the form and appearance of the horn and to confine themselves solely to the question of constructing the ribs on the outside. This would have been a gross error. As we have already pointed out, the plaintiff's invention was a combination of various elements, and one of these elements consisted in gradually tapering or curving the strips in plan outwardly from the inner to the outer end, but with the curve more abrupt adjacent the outer end, whereby a flaring or bell-shaped horn was produced. This was one of the elements of the invention, and it relates to the shape and configuration of the horn. The theory of this requested instruction is that the invention related solely to the form of construction of the ribs on the outside, but that is a misconception of the invention. The learned judge,

at pages 272-3, carefully analyzed the invention and pointed out the various elements which go to make up the combination. One of those elements refers to the shape and form of the horn.

This requested instruction further goes on to state that the invention must be limited to the "precise construction" described in the patent. Such an instruction would have been an error, because the invention is not limited to the precise construction, but, as is the case of all patents, is entitled to mechanical equivalents of the construction shown.

ASSIGNMENT OF ERROR XXVII undertakes to instruct the jury regarding the prior patent of Villy stated to be "dated.....1903," which was offered for the purpose of anticipation. The court refused to give the instruction for the reason that it was not proper to instruct the jury on questions of fact. It was for the jury, not the court, to say what was disclosed by the prior patent of Villy, as well as all the other prior patents in the case, and the court left that matter for the jury, where it properly belonged. The court did instruct the jury on the principles of law relating to anticipation, as will be seen by reference to page 275 of the Record, and that was all that was necessary or proper. It would have been error for the court to have told the jury what the prior patents disclosed, or to have told the jury that "the plaintiff's expert witnesses as well as the defendant's testified point

“blank that the machine described in this patent  
“(Villy) was constructed in the same manner as the  
“machine described in plaintiff’s patent, and in fact  
“was the same thing.” We do not know of any such  
testimony in the case and we challenge opposing counsel to point it out. But if there was any such testimony, it was not the duty of the court to state it to the jury and call their attention to the same in the manner requested, thereby making the instruction argumentative and tending to induce in the mind of the jury the belief that the court thought the patent invalid.

While it is not necessary for us to discuss this prior Villy patent, inasmuch as the questions involved in the case concerning it were questions of fact and are conclusively settled by the verdict of the jury, yet we venture to say a word regarding it for the purpose of showing that the jury was right in holding that it was no anticipation. That patent shows a collapsible horn, that is to say, one made so that it can be folded up and stowed away in a box when not in use. It is not a permanently self-sustaining horn. The fundamental idea consists in the collapsible feature. The object of the invention, as stated in the patent, is “to  
“provide a horn or trumpet-like device which can be  
“folded when not in use so as to be capable for ready  
“transportation and for placing within the case of  
“the phonograph or in the pocket of the user when  
“it is to be applied to an ear instrument or the like.”

With that end in view it is made of a series of strips "of paper, wood, linen, or other flexible material," and the foundation is made of linen or the like so as to form a hinge-like connection between the strips. In other words, a series of strips of paper are glued together along their longitudinal edges on a backing of linen, so that they can be folded up. The edges are not permanently joined together, nor are there any ribs or pretense of ribs formed by the seams. This horn differs from the Nielsen invention in that it is collapsible and is not a rigid, self-sustaining horn, is made of strips of paper or the like instead of metal, and is not provided with ribs along the edges of the strips or elsewhere. Now whether or not such a horn operated as an anticipation was a question of fact which was submitted to the jury and which the jury decided in our favor. Hence, it cannot be reviewed by this court. Furthermore, this Villy horn does not appear ever to have gone into use or to have cut any figure in the art and is nothing more than one of those unsuccessful paper inventions which serve only to accentuate the value of the Nielsen invention.

We have received no brief from plaintiff in error. If such is hereafter filed, we shall ask leave to answer it.

Respectfully submitted.

JOHN H. MILLER,  
WM. K. WHITE,

For Defendant in Error.

Dated October 25, 1913.

